

REMARKS

Claims 1-5 will remain pending in the above-identified application and stand ready for further action on the merits.

Enclosed 37 CFR § 1.132 Declaration

Enclosed herewith is a 37 CFR § 1.132 Declaration of Mr. Masayoshi HANDA, which contains therein comparative testing results that material to a consideration of the patentability of the instant invention over the disclosure of Wada et al. (US 6,150,582). The Examiner is respectfully requested to review Mr. HANDA's enclosed declaration at this time as it contains comparative testing results that are material to a consideration of both the novelty and non-obviousness of the instant invention over the cited art of Wada et al. US 6,150,582

Drawings Objection

The drawings have been objected to by the USPTO under the provisions of 37 CFR § 1.83(a); however, reconsideration and withdraw of this objection is respectfully requested based on the following considerations and the provisions of 37 CFR § 1.81(a), which recites as follows:

37 CFR § 1.81 Drawings required in patent application.

- (a) *The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction. (Emphasis Added)*

In instantly pending dependent claim 5, the inventive feature of the claimed invention is the absorbent that is present in the absorbent article (which absorbent is recited in independent claim 1.)¹

Accordingly, other than the specific absorbent utilized therein, it is submitted that the three layered constitution of the absorbent article that is recited in claim 5 (*i.e., an absorbent interposed between a liquid-permeable sheet and a liquid-impermeable sheet*) is well known to those skilled in the art, and thus a drawing of the absorbent article of claim 5, *per se*, is not necessary for an understanding of the subject matter recited in pending claim 5. As such, reconsideration and withdraw of the outstanding drawings objection is respectfully requested at present.

Claim Rejection - 35 USC § 102(b)/103(a)

Claims 1-5 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by, or in the alternative, under 35 USC § 103(a) as obvious over **Wada et al.** US '582 (US 6,150,582).

Reconsideration and withdraw of the above rejection is respectfully requested based on the following considerations.

¹ Instant claim 5 recites as follows: An absorbent article comprising the absorbent according to claim 1 interposed between a liquid-permeable sheet and a liquid-impermeable sheet.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int'l Co. v. Teleflex Inc.*, 127 SCt 1727, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Accordingly, while the courts have adopted a more flexible teaching, suggestion, motivation (TSM) test in connection with the obviousness standard based on the *KSR v. Teleflex*

case, which case involved a mechanical device in a relatively predictable technological area, it remains true that, despite this altered standard, the courts recognize inventors face additional barriers in relatively unpredictable technological areas as noted in *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 83 USPQ2d 1169 (Fed. Cir. 2007).

Further, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

Distinctions Over the Cited Art

Enclosed Declaration of Mr. HANDA

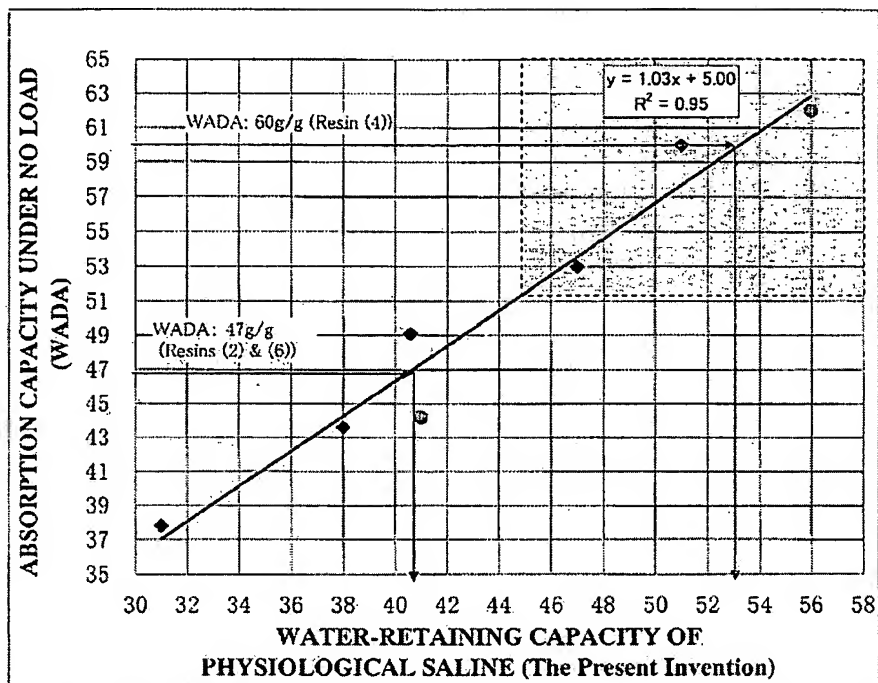
In the enclosed Declaration of Mr. HANDA, comparative testing has been carried out focusing on water-absorbent resin (4) of Wada et al. US ‘582, which comparative testing shows the largest absorption capacity under no load among the water-absorbent resins disclosed in the cited Wada et al. US ‘582 reference (and additionally when conducting of a follow-up test therefore). The specific details of the testing are set forth in Mr. HANDA’s Declaration attached hereto.

However, in sum, at least the following two points are shown by way of comparative testing set forth in Mr. HANDA’s enclosed 37 CFR § 1.132 declaration:

First, absorption capacity under no load in Wada and water-retaining capacity (b) of physiological saline are well correlated to each other. As shown in the correlation graph at page 12 of the enclosed declaration (and shown below), other water-absorbent resins except for the water-absorbent resin (4) do not appear to satisfy the requirements for water-retaining capacity (b) of physiological saline at all.

Second, the water-retaining capacity (b) of physiological saline of Water-absorbent resin (4) in Wada would correspond to about 53 according to the correlation graph show at page 12 of the enclosed Declaration (and shown below). However, according to our follow-up test for Water-absorbent resin (4), water-retaining capacity (b) of physiological saline was 29, which is very low. Therefore, we consider that absorption capacity under no load of 60 would be in error.

For the Examiner's convenience, the following correlation graph, table and paragraphs are copied from sections "3-1." and "3-2.", at pages 12-13 of Mr. HANDA's enclosed declaration, and are provided herein for the Examiner's convenience and ease of understanding the patentable distinction of the present invention over the cited Wada US '582 reference.



It can be seen from the measurement results for the water-absorbent resins of the present invention and the commercially available water-absorbent resins that both of the measurement values are well correlated. From the correlation, since the water-absorbent resins (2) and (6) of Wada have absorption capacity under no load of 47 g/g, a water-retaining capacity of physiological saline as measured by the method described in the present invention would be about 40 to 42 g/g or so, which are considered to be outside the claimed range of the present invention where the water-retaining capacity of physiological saline is 45 g/g or more.

...

	Parameters of WADA					Parameters of the Present Invention	
	Absorption Capacity Under No Load	Absorption Capacity Under Load	Amount of Water-Soluble Component	Absorption Speed	Urine Resistance Index	Water-Retaining Capacity	Water Absorption
Water-Absorbent Resin (B)	38	26	7	54	0	29	46
Values Disclosed in Wada	60	13	13	48	0	-	-

As shown in the above results, the water-absorbent resin (B) synthesized in accordance with Wada was found not to have the properties of the absorption capacity under no load as disclosed in Wada, i.e., 38 vs. 60. Since the numerical figures on other properties, such as absorption capacity under load, the amount

of water-soluble component, the absorption speed, and the urine resistance index of the water-absorbent resin (B) fairly approximate those disclosed in Wada, it is assumed that there should be some sort of typographical errors in the absorption capacity under no load (namely, the value therefor should have been far lower than 60 g/g).

Accordingly, based on such comparative testing it is clear that the cited Wada US '582 reference does not teach, provide for, or otherwise envision an absorbent as recited in instant independent claim 1, which recites:

An absorbent comprising a water-absorbent resin and a hydrophilic fiber, characterized in that said water-absorbent resin has a water absorption (a) of physiological saline of 60 to 100 g/g and a water-retaining capacity (b) of physiological saline of 45 to 80 g/g, and that the water absorption (a) of physiological saline and the water-retaining capacity (b) of physiological saline satisfy the relationship of the formula:

[Water absorption (a) of physiological saline] \geq [Water-retaining capacity (b) of physiological saline] + 15.

As such, based on the comparative testing set forth in the enclosed 37 CFR § 1.132 Declaration of Mr. HANDA, it is submitted that instant claim 1, as well as dependent claims 2-5 that all depend claim 1, are neither anticipated by nor rendered obvious by the cited Wada US '582 reference. In this respect, the comparative testing shows that the absorbent of Wada does not meet each of the limitations of the instant claims, and the Examiner has provided no reason or rationale that would allow one of ordinary skill in the art to arrive at the instant invention upon considering the full disclosure of the cited Wada et al. reference.

Any contentions of the USPTO to the contrary must be reconsidered at present.

CONCLUSION

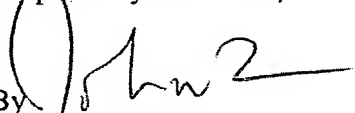
Based upon the remarks presented herein, and comparative testing set forth in the enclosed 37 CFR § 1.132 declaration of Mr. HANDA, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-5 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: June 12, 2008

Respectfully submitted,


By _____

John W. Bailey
Registration No.: 32,881
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachments: 37 CFR § 1.132 Declaration of Mr. Masayoshi HANDA